

REMARKS/ARGUMENTS

In the specification description and explanation of Figures 4, 5 and 6, has been inserted after the paragraph ending on line 4 of page 4 and the paragraph ending on line 2 of page 8. Support for this text may be found in US patent No. 5,965,235 figures 5, 8, 9 and 10 and at column 4, line 10 to 29, column 15, line 15 to column 17 line 67. Support for incorporation of this disclosure of US patent No. 5,965,235 may be found at page 7 line 19 to 22, where this patent is specifically incorporated by reference. This text provides explanation and illumination of Figures 4, 5 and 6, addition of which was requested in the Office Action.

Furthermore, additional Figures 4, 5 and 6 have been added to comply with the request in the Office Action for drawings of three-dimensional films. Support for these Figures may also be found in US patent No. 5,965,235 figures 5, 8, 9 and 10 and at column 4, line 10 to 29. Support for incorporation of these figures of US patent No. 5,965,235 may be found at page 7 line 19 to 22, where this patent is specifically incorporated by reference.

Figures 1 and 3 have also been amended to include the reference numeral 70 (cutting means) as requested in the Office Action.

Claims 1, 5 and 10 have been amended to replace the term "can be". Furthermore, Claims 1 and 10 have been amended to include the limitations of Claim 2, which has been canceled without prejudice, as well as further clarifying that the means for separating is a cutting blade.

In light of the length of the proposed amendments to the specifications a substitute copy of the specification, as well as a marked up copy version is submitted in accordance with 37 C.F.R. §1.125. The substitute specification and the marked up copy version contain no new matter.

Claims 2, 4 and 11 have been canceled without prejudice, Claims 12-20 have been withdrawn and Claims 1, 3, and 5-10 remain pending in the present application. No claims and no new matter have been added, and no additional claim fee due. Entry of this Amendment is respectively requested.

OBJECTIONS

1) Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the reference numeral 70 mentioned in the description. Applicants are submitting a corrected set of figures which include the reference numeral 70.

The drawings are objected to under 37 CFR 1.83(a). The Office Action notes that the drawings must show every feature of the invention specified in the Claims and therefore must include a drawing(s) of the three-dimensional film of Claim 6 and the curved passage way of Claim 11.

Applicants are submitting additional Figures 4, 5 and 6 to comply with the request in the Office Action for drawings of three-dimensional films. Support for these Figures may also be found in US patent No. 5,965,235 figures 5, 8, 9 and 10 and at column 4, line 10 to 29. Text is also being added to the specification to provide explanation and illumination of additional Figures 4, 5 and 6. Support for incorporation of these figures and text of US patent No. 5,965,235 may be found at page 7, line 19 to 22, where this patent is specifically incorporated by reference.

As to Claim 11, it is canceled without prejudice thereby rendering the objection moot.

In view of the foregoing remarks, additional figures and the clarifying amendments, it is respectfully requested that the objections to the figures be reconsidered and withdrawn.

REJECTIONS

Rejections Under 35 U.S.C. §112

35 U.S.C. §112 Second Paragraph

1) Claims 1-11

Claims 1-11 have been rejected under 35 U.S.C. §112 second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Office Action noted that the phrase "can be" renders the scope of the claims indefinite.

Applicants are amending Claims 1, 5 and 10, the only claims where the term “can be” appears. In Claims 1 and 10 “can be” has been replaced with “is” and in Claim 5 the phrase “can be closed” has been replace with the phrase “are closeable”.

As to Claim 11, it has been canceled without prejudice thereby rendering the rejection of this claim moot.

Consequently, in view of the foregoing remarks and the clarifying amendments, it is respectfully requested that the rejection of Claims 1 to 11 be reconsidered and withdrawn.

2) Claim 4

Claim 4 has been rejected under 35 U.S.C. §112 second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Office Action noted that the phrase “separating means comprises a separable region within the tubular sheet” renders the scope of the claims indefinite.

Claim 4 has been canceled without prejudice thereby rendering the rejection of this claim moot. Consequently, in view of the foregoing remarks and the clarifying amendments, it is respectfully requested that the rejection of Claim 4 be reconsidered and withdrawn.

3) Claim 11

Claim 11 has been rejected under 35 U.S.C. §112 second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Office Action noted that the phrase “the passage way is curved and is preferably an elbow” renders the scope of the claims indefinite.

Claim 11 has been canceled without prejudice thereby rendering the rejection of this claim moot. Consequently, in view of the foregoing remarks and the clarifying amendments, it is respectfully requested that the rejection of Claim 11 be reconsidered and withdrawn.

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Rejections Under 35 U.S.C. §102

Lecomte

Claims 1-4, 8 and 11 have been rejected under 35 U.S.C. §102(e) as being anticipated by Lecomte US Patent No 6,065,272. It is the Examiner's contention that that the claimed articles are anticipated by the disclosure of Lecomte. Applicants respectfully traverse the rejection.

Section 2131 of the MPEP states to anticipate a claim, the reference "MUST TEACH EVERY ELEMENT OF THE CLAIM" (emphasis in original). Applicants respectfully submit that all the claim limitations are not taught or suggested by Lecomte, as shown below.

Applicants submit that Lecomte does not teach every element of Applicants' amended Claim 1. Applicants' claimed invention requires that the separating means be a "cutting blade". This element is missing from Lecomte, which must comprise a set of "heat sealing pliers". See Lecomte column 5 line 20. Lecomte does not teach each and every claim element.

As to Claim 11, it has been canceled without prejudice thereby making the rejection of Claim 11 over Lecomte moot.

In view of the foregoing remarks and the clarifying amendments, it is respectfully requested that rejection of Claim 1-4, 8 and 11 be reconsidered and withdrawn.

Rejection under 35 U.S.C. 103

1) Lecomte in view of Daelmans

Claims 5, 6 and 7 are rejected under 35 U.S.C. §103 as being obvious over Lecomte, US Patent No 6,065,272 in view of Daelmans et al., US Patent No 5,935,686. It is asserted in the Office Action that the claimed device is obvious in light of what is taught by Lecomte in view of Daelmans. Applicants respectfully traverse the rejection.

It is well known that to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. In re Rouffet 149 F.3d 1350, 47 USPQ.2d 1453 (Fed. Cir. 1998). Second, there must be a reasonable expectation

of success. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. See MPEP 2143.01; In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990); and In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992). Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. MPEP706.02(j); In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); and MPEP Section 2143 - Section 2143.03.

Turning to the present rejection, it is clear that the Office Action has failed to establish a *prima facie* case of obviousness. For a start one of ordinary skill would have no motivation to combine Lecomte with Daelmans. In Lecomte the invention is directed to the heat-sealing of various types of waste. Contrast this with Daelmans which is specifically directed to a cold wrap process. Furthermore, Daelmans is directed to cold wrapping of mass produced consumables, such as confectionary products, and exemplifies wrapping of mass produced chocolate at a rate of 1200 products per minute. Heat-sealing of such products would result in at least damage, possibly destruction of the wrapped product. Lecomte on the other hand is directed to heat sealing, wrapping and containment of waste, such as household waste. One of ordinary skill would not consider Daelmans relevant and have no motivation to combine Lecomte with Daelmans. Daelmans teaches away from any combination with Lecomte since it is a cold wrap process and Lecomte is a heat-sealing process. Furthermore, one of ordinary skill would not consider Daelmans relevant since it is directed to a cold wrap for use in the mass production of small food items, whereas Lecomte relates to heat-sealing of waste, such as household waste.

Applicants' invention, as now claimed, comprises as the separating means a cutting blade. There is no teaching or suggestion in either Lecomte or Daelmans or any possible combination thereof of a cutting blade. Daelmans is wholly silent on this issue, whereas Lecomte only talks about heat-sealing pliers for cutting after welding. The heat-sealing pliers of Lecomte remove the portion of the sleeve containing the waste from the remainder of the sleeve by heat and not mechanical separation or cutting as Applicant's

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claimed invention does. It would be readily apparent to one of ordinary skill that heat-sealing pliers are different to a cutting blade and perform substantially different functions.

Furthermore, it is apparent that the rejection is applying the "obvious to try" standard which has been consistently held improper. It is well settled that the question of obviousness under 35 U.S.C. §103 is not what the artisan could have done, but rather what would have been obvious for such a person to do. See Orthokinetics, Inc. v. Safety Travel Chairs, Inc., 1 U.S.P.Q.2d 1081 (Fed. Cir. 1986), and In re Brouwer, 37 U.S.P.Q.2d 1663 (Fed. Cir. 1996). See also MPEP 2143.01; In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). It is unclear as to why one of ordinary skill would consider the combination of Lecomte and Daelmans relevant as they fails to teach or suggest all of the claim limitations. Furthermore, there is no teaching, motivation and/or suggestion to one of ordinary skill modify any possible combination of Lecomte and Daelmans and the only suggestion provided in the Office Action has been impermissible hindsight based on Applicants' own teaching.

Additionally, even if one of ordinary skill were to combine Lecomte and Daelmans they would have no reasonable expectation of success. Lecomte involves heating of a heat sealable plastic sleeve, whereas Daelmans is directed to a cold sealing plastic coated film. There is no teaching or suggestion in Lecomte on incorporating material on to the plastic sleeve. Likewise there is no teaching or suggestion in Daelmans of heating the cold sealing plastic coated film, if anything the fact that the film is a cold sealing film teaches away from application of heat. In light of this teaching one of ordinary skill would have no reasonable expectation of success in any possible combination of Lecomte and Daelmans.

Consequently, in view of the foregoing remarks and the clarifying amendments, it is respectfully requested that the rejection of Claims 5, 6 and 7 be reconsidered and withdrawn.

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2) Lecomte

Claims 9 and 10 are rejected under 35 U.S.C. §103 as being obvious over Lecomte, US Patent No 6,065,272. The Office Action asserts that both the handle and an oval opening portion are obvious since "it appears that the invention would perform equally well without the handle and the outlet opening is not an oval shape". Applicants respectfully traverse this assertion.

The phrase "it appears that the invention would perform equally well without the handle and the outlet opening is not an oval shape" is not clear as to what it means. Is the phrase, for example, referring to some teaching in Lecomte, Applicants claims or something else? Applicants request clarification on this rejection.

In any event, both Claims 9 and 10 now require the device to include a cutting blade which is neither taught, suggested or disclosed in Lecomte. Consequently, the rejection of Claims 9 and 10 in the Office action is rendered moot.

Consequently, in view of the foregoing remarks and the clarifying amendments, it is respectfully requested that the rejection of Claims 9, and 10 be reconsidered and withdrawn.

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Conclusion.

In light of the amendments and remarks presented herein, Applicants respectively submit that Claims 1, 3, and 5-10 are allowable over the prior art of record or any combination thereof. In the event that issue remain prior to allowance of the noted claims, then the Examiner is invited to call Applicant's undersigned agent to discuss any remaining issues.

Respectfully submitted,

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